

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

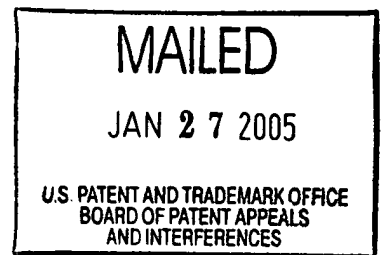
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES J. RUNKLE,
AMITAVA SENGUPTA, and TONY R. VIDO

Appeal No. 2004-2240
Application No. 09/851,242

ON BRIEF



Before PAK, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a careful review of the record in this appeal, we determine that this application is not in condition for a decision at this time. Accordingly, pursuant to our authority under 37 CFR § 41.50(a)(1) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), we remand this application to the jurisdiction of the examiner for action consistent with our remarks below.

Appellants' invention relates to a method for making a hollow fiber membrane contactor wherein a hollow fiber fabric is wound around a center tube and the tube and fabric are potted

together to form a unitized structure. Thereafter, the unitized structure is placed in a shell and the structure and shell are mold-potted together via the injection of a potting material into a space between the structure and shell. A further understanding of the invention can be derived from a reading of exemplary claims 1 and 21, reproduced in an Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bikson et al. (Bikson)	4,800,019	Jan. 24, 1989
Caskey et al. (Caskey)	4,961,760	Oct. 09, 1990
Mancusi et al. (Mancusi)	5,186,832	Feb. 16, 1993
Huang et al. (Huang)	5,284,584	Feb. 08, 1994

Claims 1, 2, 4, 5, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mancusi in view of Bikson. Claims 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mancusi in view of Bikson and Caskey. Claims 1, 2, 4, 5, 16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mancusi and Bikson. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mancusi, Bikson and Caskey. Claims 21-23, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mancusi in view of Bikson and alleged admitted prior art. Claims 24-26 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Mancusi in view of Bikson, Caskey and alleged admitted prior art. Claims 21-24 and 26-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mancusi, Bikson and alleged admitted prior art. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Mancusi, Bikson, Caskey and alleged admitted prior art.

Two pivotal issues relative to all of the rejections advanced by the examiner that have been raised on this appeal are: (1) whether or not Mancusi reasonably discloses or suggests the use of two potting steps; and, (2) whether or not Mancusi together with Bikson teach or suggest a second potting step involving a mold-potting of the shell and unitized structure (previously potted fabric and tube structure) as an obvious option to one of ordinary skill in the art.

However, in applying Mancusi to the claimed subject matter, the examiner appears to have confusingly referred to portions of several separate options for forming a cartridge disclosed in the patent without fully explaining how each of those separate embodiments of Mancusi considered alone, or in combination with Bikson, teach or suggest the claimed process including two potting steps reasonably corresponding to appellants' claimed

potting steps. For example, we note that Mancusi (column 9, lines 53-55) draws a distinction between cartridges that are cast-in-place into a module and those that are inserted into a pressure housing.¹

Concerning the fabrication of cast-in-place modules, Mancusi (column 9, line 63 through column 10, line 26) teaches that a bundle (as prepared above) is inserted into a cast-in-place housing and the bundle ends are sealed with a potting cup clamped over the housing ends. The examiner should determine whether or not that sealing step in forming the cast-in-place module corresponds to or would have suggested the claimed mold-potting step to one of ordinary skill in the art. Then, the examiner, should further determine whether or not the bundle employed in making that cast-in-place module of Mancusi would have been

¹ In contrast to forming cast-in-place modules, Mancusi (column 10, lines 41-60) teaches that relatively large cartridges should be potted by forming end seals for the bundle ends concurrently with a winding step without employing a subsequent potting step. For that embodiment, the examiner should further explain (to the extent the examiner maintains the rejection after remand based on that embodiment) how Mancusi in combination with Bikson's teachings respecting the use of molds in potting and sealing bundle ends prior to installing the hollow fiber bundle into an enclosure would have reasonably suggested to one of ordinary skill in the art using a second mold-potting step, as appellants' claim, for potting the structure and shell together. See column 4, line 48 through column 9, line 36 of Bikson.

understood by one of ordinary skill in the art as including a potted bundle that was formed by winding a hollow fiber fabric around a tube and subsequent potting thereof as described above in Mancusi (column 8, line 44 through column 9, line 4). If so, the examiner should explain how that cast-in-place manufacturing method corresponds to appellants' claimed method (see at least claim 1) on a claim-by-claim basis to the extent the claims are separately argued.

In addition, we note that notwithstanding appellants' numerous remarks and reliance on a declaration of Charles J. Runkle in both the brief (pages 21 and 22, and Exhibit A), and the reply Brief (pages 10, 18 and 19), the examiner has failed to mention that declaration or particularly address appellants' remarks concerning that declaration in the answer.

Secondary considerations of obviousness, such as the Runkle declaration, when entered into the record, must be considered by the examiner. See Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1186 (Fed. Cir. 1997); see also Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). However, on this record, the examiner has not specifically addressed in the answer to appellants' declaration (mentioned both in the brief and the reply brief as

noted above; see the answer in its entirety). The answer should reflect that appellants' arguments and any entered evidence relied upon were weighed against the examiner's evidence of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Accordingly, we remand this application to the jurisdiction of the examiner for a thorough and careful consideration of the matters discussed above in a Supplemental Examiner's Answer should any of the rejections be maintained.

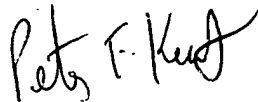
Pursuant to the provisions of 37 CFR § 41.50(a)(2) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellants are required to timely respond to any supplemental examiner's answer issued in response to this remand. As stated in this rule, appellants must exercise one of the two following two options to avoid sua sponte dismissal of the appeal as to the claims involved in the remand: (I) request that prosecution be reopened before the examiner by filing a reply under Rule 111 with or without amendment or evidence or (II) request that the appeal be maintained by filing a reply brief as provided in § 41.41.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01 (D) (8th ed., Rev. 2, May 2004, p. 700-126). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

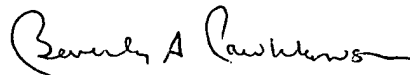
REMANDED



CHUNG F. PAK
Administrative Patent Judge



PETER F. KRATZ
Administrative Patent Judge



BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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